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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,373	03/31/2004	Andrew L. Oleson	1199 P 196	5499

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IP DEPARTMENT
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EXAMINER	
FERGUSON SAMRETH, MARISSA LIANA	
ART UNIT	**PAPER NUMBER**
2854	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,373	OLESON, ANDREW L.	
	Examiner	Art Unit	
	Marissa L. Ferguson-Samreth	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *51,52 and 59-80* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *51,52 and 71-80* is/are allowed.

6)☒ Claim(s) *59-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 59 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Oleson (US Patent 5, 921,176) in view of Iwamoto et al. (JP 2000203034) and Rivin (US Publication 2003/0185624).

Regarding claims 59 and 65, Oleson teaches a frame (10) holding the screen (12) and one or more frame holders (10) for supporting each screen (12) above the item (T) I printed on. However he does not teach a first and second set of shims/spacers having one or more shims, generally uniform predetermined thickness for each frame holder and each shim and wherein each shim of each set adapted to be optionally positioned between a frame holder and the frame such that the shims of a set can be used simultaneously with all of the frame holders in a number of different combinations to adjust and evenly increase the vertical distance and space between the frame and the item to be printed upon.

Iwamoto et al. teaches a method of screen printing of a glass substrate wherein a shim spacer is positioned in a space between a runner and a table and wherein the shim spacer of a set can be used simultaneously in a number of different combinations

to adjust and evenly increase the vertical thickness (Constitution, Lines 16-32) and space between the table and the item to be printed upon (this limitation is not positively claimed and the set of shims in the prior art has the capability of being simultaneously used in different combinations).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Oleson to include a shim spacer as taught by Iwamoto et al., since Iwamoto teaches that it is advantageous to appropriately adjust the elevation thereby enabling good print quality.

However, Oleson and Iwamoto et al. does not teach a second set of shims/spacers having one or more shims and wherein the shims have generally uniform predetermined thickness. Rivin teaches a set of uniform thickness (Page 2, Paragraph 0024, Lines 13-15) elastomeric shims (elements 12,13). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Oleson to replace the shim thereof with a shim of uniform thickness as taught by Rivin, since Rivin teaches that it is advantageous to provide a less bulky and uniform shim that reduces frictional losses.

Oleson, Iwamoto et al. and Rivin do not teach a second set of shims/spacers having one or more shims. Iwamoto et al. teaches a set of shim spacers including one shim, however it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. ***In re Harza 124 USPQ 400.*** It would have been obvious to add a second shim spacer, since such a modification would result in a frame having additional support thereby providing a stable framing structure.

2. Claims 60, 63, 64, 66, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Oleson (US Patent 5, 921,176) in view of Iwamoto et al. (JP 2000203034) and Rivin (US Publication 2003/0185624) as applied to claims 59 and 65 above, and further in view of Deschenes (US Publication 2002/0148172).

Regarding claims 60 and 66, Oleson, Iwamoto et al. and Rivin all teach a method and apparatus claimed with the exception of wherein each shim has a means associated therewith for interconnecting the shim to another shim and/or to a frame holder such as a contact area. Deschenes teaches a thin strip of wood (element 15 can function as the means for interconnection) that joins the surfaces of both shims/spacers together (Abstract and Paragraph 0032) and uses an adhesive tape (30) for holding shim assemblies of one row to another row during shipping.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Oleson in view of Iwamoto et al. and Rivin to have an interconnection means as taught by Deschenes, since Deschenes teaches that it is advantageous to properly and effectively join the shims together in a secure manner.

Regarding claims 63,64 and 69, Oleson, Iwamoto et al. and Rivin all teach a method and apparatus claimed with the exception of each set of shims or one or more sets having one or more shims and the first predetermined thickness can be the same or different than the second predetermined thickness. Deschenes teaches a bundle/package of shims/spacers (18,28) having different predetermined thicknesses (Abstract and Page 2, Paragraph 0031).

Also, specifically regarding claim 70, Deschenes teaches a package of shims/spacers, which includes multiple sets of shims/spacers (3 or more as shown in figures 8 and 9). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Oleson, Iwamoto and Rivin to have a plurality of shims/spacers of different thicknesses as taught by Deschenes, since Deschenes teaches that it is advantageous to have selectable thicknesses to provide an easier method of properly aligning shims.

3. Claims 61,62,67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Oleson (US Patent 5, 921,176) in view of Iwamoto et al. (JP 2000203034), Rivin (US Publication 2003/0185624) and Deschenes (US Publication 2002/0148172) as applied to claims 59 and 65 above, and further in view of Ingold (US Patent 4,713,922).

Regarding claims 61 and 67, Oleson, Iwamoto et al., Rivin and Deschenes all teach the claimed method and invention with the exception of a method and apparatus comprising at least one fastener for each frame holder to interconnect the shims disposed between the frame and the frame holder either to each other and/or to the frame holder. Ingold teaches a frame mounting structure with at least one fastener for interconnecting sets of shims/spacers disposed between a door-mounting unit (element 24 and Column 4, Lines 24-33 and Lines 52-63).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Oleson,

Iwamoto et al., Rivin and Deschenes to replace the interconnection thereof with a fastener interconnection as taught by Ingold, since Ingold teaches that it is advantageous to provide expandable shim surfaces to allow for the adjustment needed to provide a secure connection.

Regarding claims 62 and 68, Oleson, Iwamoto et al., Rivin and Deschenes all teach the claimed method and invention with the exception of a mechanism for holding the frame in the frame holder and the same mechanism will hold the frame and one or more shims in the frame holder below the frame and between the frame holder and the frame. Ingold teaches a frame mounting structure wherein each frame structure includes a studding mechanism for interconnecting (7) for the one or more shims/spacers (12,14) in the mounting connection (Column 5, Lines 53-68 and Column 6, Lines 1-6).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Oleson, Iwamoto et al., Rivin and Deschenes to include a mechanism for holding the frame and the shims as taught by Ingold, since Ingold teaches that it is advantageous to provide a secure and permanent connection thereby preventing movement of the frame and shims.

Allowable Subject Matter

4. Claims 51,52 and 71-80 are allowed

5. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 51, the prior art does not teach or render obvious a method for modifying an existing printing press to accept a pair of height-adjusting shims comprising the steps of: positioning each one of the pair of shims on each of a pair of opposed frame holders, determining at least one location for an aperture on each of the opposed frame holders to facilitate fastening of the pair of shims to the pair of opposed frame holders, positioning a drill bit on each of the opposed frame holders at the determined location and drilling a hole in each of the opposed frame holders at the determined location.

Regarding claims 71 and 76, the prior art does not teach or render obvious a method for adjusting the vertical height of a frame for a screen supported by one or more frame holders relative to an item to be printed upon comprising the step of positioning the selected at least one set of shims simultaneously between a frame holder and the frame to adjust and evenly increase the vertical distance between the frame and the item to be printed upon.

Response to Arguments

6. Applicant's arguments filed 4/10/07 have been fully considered but they are not persuasive. Regarding applicant's comments for claims 59 and 65 on page 6, 3rd

paragraph, the examiner notes that Oleson was not used for the claimed feature of "placing shims of the same size and thickness on opposing frame holders".

In response to applicant's arguments of claims 59 and 65 that Iwamoto et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Iwamoto et al. teaches a method of screen printing with spacers. The claimed limitation, "each shim of each set to be optionally positioned between a frame holder and the frame such that the shims of a set can be used simultaneously with all the frame holders in a number of different combinations to adjust and evenly increase the vertical distance and space between the frame and the item to be printed upon", is functional language and the prior art has the capability of performing the intended function.

In response to applicant's arguments of claims 59 and 65 that Rivin is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rivin teaches elastomeric shims with uniform thickness. Also, the applicant remarks concerning "one of ordinary skill in the art of printing T-shirts and the like.....", the examiner notes that claim is not claiming a T-shirt or the like. The

claimed limitation states an item to be printed and in does not particularly point out the item to be printed is a T-shirt or the like. Rivin is simply being used to teach uniform thickness.

In response to applicant's arguments of claims 60, 63, 64, 66, 69 and 70 that Deschenes is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Deschenes teaches using strips of wood or/and an adhesive to interconnect the shims to a frame holder. The prior art was mainly used for interconnection purposes. The examiner would like to note that the preamble states a screen printing machine, however screen printing is not positively claimed in the claims.

In response to applicant's arguments of claims 61, 62, 67 and 68 that Ingold is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ingold teaches a fastener to interconnecting a mounting unit. The applicant on page 10, last sentence again points out, that the prior art is not pertinent to printing press and screen printing machines, however, the examiner would

like to point out that the printing press or screen printing machine is noted in the preamble.

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976)and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 59-70 are directed to an assembly containing shims. The purpose for which these shims are used, as recited by applicant in a "for use" type statement, carries no patentable weight. Thus applicant is only reciting structure of the shims and of an assembly containing shims. Therefore, any prior art regarding shims, is relevant and usable as prior art against the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson-Samreth whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
Art Unit 2854

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